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NOTICE OF ALLOWANCE AND FEE(S) DUE

38881 7590 12/03/2009

DICKSTEIN SHAPIRO LLP
1633 Broadway
NEW YORK, NY 10019

EXAMINER	
DAVIS, ZACHARY A	
ART UNIT	PAPER NUMBER
2437	

DATE MAILED: 12/03/2009

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,108	07/15/2003	Marcus Janke	S0193.0158	8615

TITLE OF INVENTION: SECURITY MODULE WITH VOLATILE MEMORY FOR STORING AN ALGORITHM CODE

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	$1510	$300	$0	$1810	03/03/2010

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), to: Mail **Mail Stop ISSUE FEE**
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INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

38881 7590 12/03/2009

DICKSTEIN SHAPIRO LLP
1633 Broadway
NEW YORK, NY 10019

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

Certificate of Mailing or Transmission

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

(Depositor's name)

(Signature)

(Date)

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10/620,108	07/15/2003	Marcus Janke	S0193.0158	8615

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nonprovisional	NO	$1510	$300	$0	$1810	03/03/2010

EXAMINER	ART UNIT	CLASS-SUBCLASS
DAVIS, ZACHARY A	2437	713-175000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.

☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. **Use of a Customer Number is required.**

2. For printing on the patent front page, list

(1) the names of up to 3 registered patent attorneys or agents OR, alternatively,

(2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

1 _____

2 _____

3 _____

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE (B) RESIDENCE: (CITY and STATE OR COUNTRY)

Please check the appropriate assignee category or categories (will not be printed on the patent) : ☐ Individual ☐ Corporation or other private group entity ☐ Government

4a. The following fee(s) are submitted:

☐ Issue Fee

☐ Publication Fee (No small entity discount permitted)

☐ Advance Order - # of Copies _____

4b. Payment of Fee(s): **(Please first reapply any previously paid issue fee shown above)**

☐ A check is enclosed.

☐ Payment by credit card. Form PTO-2038 is attached.

☐ The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment, to Deposit Account Number _____ (enclose an extra copy of this form).

5. **Change in Entity Status** (from status indicated above)

☐ a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27.

☐ b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature _____ Date _____

Typed or printed name _____ Registration No. _____

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

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EXAMINER	
DAVIS, ZACHARY A	
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DATE MAILED: 12/03/2009

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)
(application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 579 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 579 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (http://pair.uspto.gov).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

PTOL-85 (Rev. 08/07) Approved for use through 08/31/2010.

Notice of Allowability	Application No.	Applicant(s)	
	10/620,108	JANKE, MARCUS	
	Examiner	Art Unit	
	Zachary A. Davis	2437	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to *the amendment received 09 July 2009*.

2. ☒ The allowed claim(s) is/are *1-4,6,7 and 9-17*.

3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a) ☒ All b) ☐ Some* c) ☐ None of the:
      1. ☒ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
      3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

   * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.

5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
   (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
   (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

   Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).

6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____ .
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

/Zachary A Davis/ Examiner, Art Unit 2437	

EXAMINER'S AMENDMENT

1. A reply to the notice of non-responsive amendment was received on 09 July 2009. By this reply, Claims 1, 2, 4, 9, 11, and 13-17 have been amended. Claims 5 and 8 have been canceled. No new claims have been added. Claims 1-4, 6, 7, and 9-17 are currently pending in the present application.

2. The Examiner notes that Applicant has clarified that the "parallel Japanese patent application" referred to in the present response (page 11) refers to Japanese application no. JP 2004519050.

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Examiner's Amendment

3. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Laura Brutman on 20 November 2009.

4. The application has been amended as follows:

IN THE SPECIFICATION:

Please **REPLACE** the paragraph beginning at page 4, line 31, with the following amended paragraph:

-- In accordance with a second object of the invention, there is provided a terminal for use with a security module, comprising: a data interface adapted to be coupled to the security module, for transmitting at least part of an algorithm code or the complete algorithm code from the terminal to a volatile memory of the security module and for receiving the algorithm code result from the security module, with the algorithm code concerning a processing of secrets; and a power interface for delivering power to the security module, with the volatile memory being supplied by the power, such that the same will be cleared upon an interruption of the receipt of the power from the terminal. The terminal is designated to send at least the part of the algorithm code or the complete algorithm code to the volatile memory of the security module, for each communication operation between the terminal and the security module. During the same communication operation, the terminal also receives[[.]] the algorithm code result from the security module.--

IN THE CLAIMS:

Please **REPLACE** Claims 1, 4, 6, 9, 11, 13-15, and 17 with the following amended claims.

Deleted: the claims with the following listing of claims.

1. A security module for use with a terminal, comprising:

a data interface adapted to be coupled to a terminal, configured to receive a first part of an algorithm code from the terminal, with the algorithm code concerning a cryptographic processing of ~~secrets~~ data,

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a power interface configured to receive power from the terminal;

a volatile memory configured to store the first part of the algorithm code received via the data interface, said volatile memory being coupled to the power interface in order to have power supplied thereto such that said volatile memory will be cleared upon an interruption of the receipt of the power from the terminal; [[and]]

a non-volatile memory in which a second part of the algorithm code, which is a ~~non-received~~ remainder of the algorithm code, is stored, wherein the first and second parts of the algorithm code form the complete algorithm code; and

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a processor configured to perform the algorithm code in order to obtain an algorithm code result that can be delivered to the terminal,

wherein the first part of the algorithm code ~~consists of~~ includes memory addresses of computing components necessary for performing the algorithm code[[,]] and/or jump addresses of the algorithm code pointing to partial routines within the second part of the algorithm code.

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4. A security module according to claim 1,

wherein the data interface is arranged to receive from the terminal the first part of the algorithm code in encrypted form and with a certificate, with the security module further comprising:

a means for decrypting the first part of the encrypted algorithm code ~~and the complete algorithm code~~; and

a means for examining the certificate and for preventing performing of the algorithm code depending on the examination of said certificate.

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6. A security module according to claim 1, further comprising:

a means for monitoring a predetermined security condition and for clearing the volatile memory if said predetermined security condition is fulfilled, with said security condition being selected from the group consisting of an interruption of a supply voltage, a fluctuation of the supply voltage and an interruption of a system clock.

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9. A security module according to claim 1, wherein the data interface is adapted to receive the first part of the algorithm code ~~several~~ multiple times in different versions, with the volatile memory being arranged for being overwritten by the different versions of the first part of the algorithm code at the ~~several~~ multiple times.

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11. A process for ~~computing an algorithm code result~~ cryptographically processing data using a security module, comprising:

receiving a first part of an algorithm code by means of an interface to a terminal, with the algorithm code concerning a ~~cryptographically~~ cryptographic processing of data;

storing the first part of the algorithm code in a volatile memory of the security module, with the volatile memory being coupled to the interface, to be supplied with power, such that the volatile memory will be cleared upon an interruption of the receipt of the power from the terminal, wherein a second part of the algorithm code is a ~~non-received~~ remainder of the algorithm code and is stored in a non-volatile memory of the security module;

performing said algorithm code on the security module in order to obtain cryptographically processed data; and

delivering said cryptographically processed data to the terminal,

wherein the first part of the algorithm code ~~consists of~~ includes memory addresses of computing components necessary for performing the algorithm code[[,]] and/or jump addresses of the algorithm code pointing to partial routines within the remainder of the algorithm code.

13. A terminal for use with a security module having a volatile memory being able to be supplied by power from the terminal, such that the volatile memory will be cleared

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upon an interruption of a supply of the power, and having a non-volatile memory in which a second part of an algorithm code is stored, comprising:

a data interface adapted to be coupled to the security module, for transmitting a first part of the algorithm code from the terminal to the volatile memory of the security module and for receiving cryptographically processed data from the security module, with the algorithm code concerning a cryptographic processing of ~~secrets~~ data, wherein the second part is a remainder of the algorithm code; and

a power interface adapted to deliver power to the security module, with the volatile memory being supplied by the power, such that the volatile memory will be cleared upon an interruption of the receipt of the power from the terminal,

for each communication operation between the terminal and the security module, the data interface controlled to: send the first part of the algorithm code to the volatile memory of the security module and then to receive the cryptographically processed data from the security module,

wherein the first part of the algorithm code ~~consists of~~ includes memory addresses of computing components necessary for performing the algorithm code[[,]] and/or jump addresses of the algorithm code pointing to partial routines within the remainder of the algorithm code.

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14. A process for controlling a security module using a terminal in order to obtain cryptographically processed data from the security module, the process comprising, for

each one of a plurality of communication operations between the terminal and the security module;

delivering power from the terminal to the security module;

transmitting a first part of an algorithm code from the terminal to a volatile memory of the security module, with the algorithm code concerning a cryptographic processing of data, with the volatile memory being supplied by the power, such that the volatile memory will be cleared upon an interruption of the receipt of the power from the terminal, and with the security module having a non-volatile memory in which a second part of the algorithm code, which is a ~~non-transmitted~~ remainder of the algorithm code, is stored; and

receiving the cryptographically processed data from the security module,

wherein the first part of the algorithm code ~~consists of~~ includes memory addresses of computing components necessary for performing the algorithm code[[,]] and/or jump addresses of the algorithm code pointing to partial routines within the remainder of the algorithm code.

15. A process for communication between a security module and a terminal, comprising:

transferring a first part of an algorithm code from the terminal to the security module, with the algorithm code concerning a cryptographic processing of data;

storing the first part of the algorithm code in a volatile memory of the security module, with the volatile memory being supplied by power from the terminal, such that

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the volatile memory will be cleared upon interruption of the receipt of the power from the terminal, and with the security module having a non-volatile memory in which a second part of the algorithm code, which is a ~~non-received~~ remainder of the algorithm code, is stored,

performing said algorithm code on the security module in order to obtain cryptographically processed data;

delivering said cryptographically processed data to the terminal; and

clearing said volatile memory upon an interruption of the receipt of the power from the terminal,

wherein the first part of the algorithm code ~~consists of~~ includes memory addresses of computing components necessary for performing the algorithm code[,]] and/or jump addresses of the algorithm code pointing to partial routines within the remainder of the algorithm code.

17. A security module for use with a terminal, comprising:

a data interface adapted to be coupled to a terminal, for receiving a first part of an algorithm code from the terminal, with the algorithm code concerning a cryptographic processing of data;

a power interface configured to receive power from the terminal;

a volatile memory configured to store the first part of the algorithm code received via the data interface, said volatile memory being coupled to said power interface in

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order to have power supplied thereto such that the volatile memory will be cleared upon an interruption of the receipt of the power from the terminal;

a non-volatile memory in which a ~~remainder~~ second part of the algorithm code which, along with the received first part of the algorithm code, forms [[all]] the complete algorithm code, is stored; and

a processor configured to perform the algorithm code in order to obtain cryptographically processed data that can be delivered to the terminal,

wherein the first part of the algorithm code includes memory addresses of computing components necessary for performing the algorithm code[[,]] and/or jump addresses of the algorithm code pointing to partial routines within the ~~remainder~~ second part of the algorithm code.

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Allowable Subject Matter

5. Claims 1-4, 6, 7, and 9-17 are allowed.

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6. The following is an examiner's statement of reasons for allowance:

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Independent Claim 1 is directed to a security module (e.g. smart card) including data and power interfaces coupled to a terminal, volatile and non-volatile memories, and a processor, where the volatile memory stores a first part of an algorithm code received by the data interface and is cleared when power from the power interface is interrupted, the non-volatile memory stores the remainder of the algorithm code (previously stored in the security module), the processor performs the algorithm code in order to obtain a result to be delivered to the terminal, and the first part of the algorithm code includes addresses of computing components for the code or jump addresses for partial routines within the remainder of the code. Independent Claim 11 is directed to a method corresponding to the functionality of the module of Claim 1. Independent Claim 13 is directed to the corresponding terminal, and independent Claim 14 is directed to a method corresponding to the functionality of the terminal of Claim 13. Claim 15 is directed to a method of communication between a security module and terminal encompassing the steps (or corresponding functions) recited in method Claims 11 and 14 (or corresponding Claims 1 and 13). Independent Claim 17 is directed to a security module reciting limitations similar to those of Claim 1.

The closest prior art, Schneier and Obana, disclose, for example, a security module including data and power interfaces; volatile memory storing received algorithm

code that is cleared when the power supply is interrupted, where power is supplied externally, non-volatile memory for storing code, and a processor that performs the algorithm code. Schneier and Obana further disclose a corresponding terminal and corresponding methods for their use. However, the cited prior art, alone or in combination, does not teach or suggest that the received first part of the algorithm code includes addresses for computing components for the algorithm code or jump addresses to partial routines within the remainder of the code, in combination with the other claimed limitations, as recited in each of the independent claims. Therefore, the claims are allowable over the cited prior art.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A. Davis whose telephone number is (571)272-3870. The examiner can normally be reached on weekdays 8:30-6:00, alternate Fridays off.

Deleted: <#>The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.¶
<#>¶
¶

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Zachary A Davis/
Examiner, Art Unit 2437